

REMARKS

The Applicant does not believe that examination of this response will result in the introduction of new matter into the present application for invention. Therefore, the Applicant, respectfully, requests that the response contained herein be entered in and that the claims to the present application be, kindly, reconsidered.

The Final Office Action dated February 22, 2005 has been received and considered by the Applicants. Claims 1-20 are pending in the present application for invention. Claims 1-20 are rejected by the February 22, 2005 Final Office Action.

The Final Office Action rejects Claims 1-12, and 17-20 under the provisions of 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 6,539,354 issued to Sutton et al. (hereinafter referred to as Sutton, et al.), in view of U.S. Patent No. 6,232,966 issued to Kurlander (hereinafter referred to as Kurlander). The Applicant, respectfully points out that the previous office action rejected Claims 1-12, and 17-20 under the provisions of 35 U.S.C. §102(e) as being anticipated by Sutton, et al. in view of Kurlander. The Applicant, respectfully, asserts that this constitutes a new rejection that was not necessitated by any amendment made by the Applicant.

The MPEP §706.07 details when a Final Rejection is proper on second action.

"Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c)."

The previous amendment submitted October 16, 2005 by the Applicant did not amend the claims at all. Therefore, the rejection of Claims 1-12, and 17-20 under the provisions of 35 U.S.C. §103(a) is a new rejection that was not necessitated by any action on the part of the Applicant. Accordingly, at least pertaining to Claims 1-12, and 17-20, the holding of finality is premature.

The Applicant, respectfully, requests that the Primary Examiner reconsider the holding of finality of the February 22, 2005 Office Action and withdraw the finality of the February 22, 2005 rejection.

The Final Office Action rejects Claims 1-12, and 17-20 under the provisions of 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 6,539,354 issued to Sutton et al.

(hereinafter referred to as Sutton, et al.), in view of U.S. Patent No. 6,232,966 issued to Kurlander (hereinafter referred to as Kurlander).

Regarding Claims 1 and 9, in the section labeled *Response to Arguments* the Examiner states that Sutton et al. teach a visual and synthetic speech animation resulting in the generation of facial movements based upon the input of text at col. 20, lines 47-52. The Applicants, respectfully, point out that Col. 20, lines 47-56 of Sutton et al. teach visual synthetic speech as described in the text to speech conversion process 1B. The text to speech conversion process 1B is described beginning on col. 16, line 50 and proceeds through col. 17, line 17. The text to speech conversion process 1B uses visemes that are associated with phonemes. The Applicants, respectfully, assert that is not possible to associate emoticons with phonemes as taught by Sutton et al. A phoneme is a sound that can be associated with normal text. Emoticons do not break down into ordinary text and, therefore, can not be converted into phonemes by the text to speech conversion process 1B of Sutton et al. There is no vehicle taught or suggested by Sutton et al. that make it possible to process emoticons.

The Examiner admits that Sutton et al. is deficient in teaching the use of emoticons to generate a facial movement. The Examiner asserts that Kurlander teaches the use of emoticons as a shorthand means for the generation of facial emotion. The Examiner's position is that a person of ordinary skill within the art would find it obvious to implement the emoticons for facial expressions as taught by Kurlander upon the system taught by Sutton et al. to arrive at the invention as defined by the rejected claims. However, as previously discussed, Sutton et al. employ phonemes that are associated with visemes to create an animated facial movement. It is not possible to implement emoticons upon the system of Sutton et al. because emoticons are not ordinary text. The Examiner has not indicated how the system of Sutton et al. can be modified to accommodate the emoticons taught by with Kurlander. Moreover, the Final Office Action does not provide any suggestion or reasonable expectation of success within the cited references, Sutton et al. and Kurlander that would lead a person skilled in the art to realize that the invention defined by the rejected claims is even possible.

The MPEP at §2143 states that three basic criteria must be met to establish a *Prima Facie* Case of Obviousness To establish a *prima facie* case of obviousness. "First,

there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

Regarding the first element, as previously discussed, it is not possible to implement emoticons taught by Kurlander on the system and method taught by Sutton et al. The Final Office Action fails to provide any suggestion or motivation, in either of the references that would lead a person skilled in the art to make a modification that would allow the combination suggested by the Examiner. Indeed, the Final Office Action does not even provide any rationale that would allow the emoticons taught by Kurlander to be implemented on the system taught by Sutton et al. to create any facial movements. As previously discussed, Sutton et al. requires ordinary text to create phonemes that can be associated with visemes. Emoticons are not ordinary text that can readily be converted into phonemes. The Final Office Action does not provide any rationale or mechanism that could be considered as a motivation to make the modification that would bridge this gap of inoperability.

Regarding the second element, a reasonable expectation of success, as previously discussed, it is not possible to implement the emoticons taught by Kurlander on the system taught by Sutton et al. to create facial movements. The Final Office Action has not addressed this issue of inoperability. Therefore, the Final Office Action does not provide any reasonable expectation of success for the combination of Kurlander with Sutton et al.

The third element, that the prior art references when combined must teach or suggest all the claim limitations is only satisfied by the Final Office Action using two pieces that inherently do not fit together. As previously discussed, it is not possible to implement the emoticons taught by Kurlander on the system taught by Sutton et al. to create facial movements.

The required teaching or suggestion to make the claimed combination and the reasonable expectation of success are not found in the cited prior art references, Kurlander and Sutton et al., either alone or in combination. Accordingly, the Final Office Action does not make establish a *prima facie* case of obviousness.

Regarding Claims 2-4, these claims depend from Claim 1 which as previously discussed is believed to be allowable. Therefore, Claims 2-4 are also believed to be allowable.

Regarding Claims 5 and 10, the Examiner states that in the section labeled *Response to Arguments* the Examiner states that Sutton et al. teach generation of facial animation based upon an indicator located in text and that Kurlander teaches association of emoticons that generate facial characteristics. As discussed above, it is not possible for emoticons to be used to generate facial movements using the method and system taught by Sutton et al. Therefore, this rejection is, respectfully traversed.

Regarding Claims 6 and 11, the Examiner states that Sutton et al. disclose a text-to-animation system that associates each word string with a spoken word, and wherein the spoken word is reproduced on the animated face image with at least one mouth movement on Col. 20, lines 19-21. The Applicants respectfully assert, as previously discussed, that it is not possible for the system and method as taught by Sutton et al. to implement facial animations using emoticons. The Final Office Action does not indicate any modification that would make the combination made by the Final Office operative. The Applicants, respectfully assert that not only is there is no disclosure or suggestion within Sutton et al. or Kurlander for the combination made by the Final Office Action, the combination made by the Final Office Action is completely and totally inoperative without some modification. This medication has not been provided by the Final Office Action. Therefore, this rejection is, respectfully, traversed.

Regarding Claims 17 and 19, the Examiner states that Sutton et al. disclose a method of performing visual speech on a system having a displayable animated face image comprising the steps of: converting the word strings to audio speech; converting the word strings to mouth movements on the displayable animated face image, such that the mouth movements correspond with the audio speech; converting the emoticon strings to facial movements on the displayable animated face image, such that the facial

movements correspond with expressed emotions associated with the entered emoticon strings and displaying the animated face image along with a broadcast of the audio speech at col. 20, lines 14-52. The Applicants, respectfully point out that Sutton et al. at col. 20, lines 14-52 teach that the emotion of the automatic expression can be selected, however, as previously discussed, there is no mechanism taught or suggested by Sutton et al. that would provide for animated facial movement in response to emoticons.

The Examiner admits that Sutton et al. do not teach the use of emoticons as a shorthand means for generating emotional expressions and asserts that Kurlander teaches the use of emoticon strings. As previously discussed in response to the rejection of Claims 1 and 9, it is not possible for the method and system of Sutton et al. to implement emoticons. Therefore, this rejection is, respectfully, traversed.

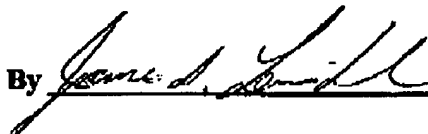
Regarding Claims 7, 12, and 18, the Examiner states that Sutton et al. disclose on Col. 20, lines 32-41 a system or program with at least one facial movement is morphed with the at least one mouth movement. The Applicant respectfully points out that, as previously discussed, it is not possible for Sutton et al. to implement facial movements using emoticons. Accordingly, this rejection is respectfully traversed.

The Office Action rejects Claims 13-16 under the provisions of 35 U.S.C. §103(a) as being unpatentable over Sutton et al. in view of Kurlander and further in view of U.S. Patent No. 5,963,217 issued to Grayson, et al. (hereinafter referred to as Grayson, et al.). The Examiner states that Grayson et al. disclose an electronic conferencing system over a computer network to import, export and translate text audio data into audible speech. The Applicant respectfully points out that, as previously discussed, the combination of Sutton et al. with Kurlander is inoperative to produce facial movements in response to emoticons. Grayson et al. do not provide any mechanism that could be considered as a bridge to the gap that exists in the basic combination of Sutton et al. and Kurlander, such as any motivation to make a modification that would allow the system of Sutton et al. to present facial movements in response to emoticons. The Final Office Action provides no disclosure, or suggestion, within the cited references that allow for using "emoticon strings" to display facial movements on the system of Sutton et al. Accordingly, this rejection is respectfully traversed.

Applicant is not aware of any additional patents, publications, or other information not previously submitted to the Patent and Trademark Office which would be required under 37 C.F.R. 1.99.

In view of the foregoing amendment and remarks, the Applicant believes that the present application is in condition for allowance, with such allowance being, respectfully, requested.

Respectfully submitted,

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